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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,903	03/31/2000	CHRISTINE DUPUIS	05725.0532	7762

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/07/2003

*LQ*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/485,903

Applicant(s)

DUPUIS ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-26, 28-36 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-26, 28-36 and 40-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Claims 18-26, 28-36, 40-48 are pending. The Amendment filed 11/15/02, Paper No. 18, cancelled claims 27, 37, 38, and amended claims 18, 32, 40, 43.

Applicant's arguments with respect to claims 18-26, 28-36, 40-48 have been considered but are moot in view of the new ground(s) of rejection.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/14/03 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34, 41 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 34 is vague and indefinite, as it is confusing. Claim 34 depends on claim 33, but claim 33 is narrower than claim 34. Thus, it is not clear how claim 34 can depend from claim 33.

(ii) The phrase "after a period of time" in claims 41 and 44 is vague and indefinite, as this term is relative. What is a period of time? Is it a minute? Is it an hour? Is it 2 days? What is a period of time?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21, 24-26, 28-32, 35, 36, 40-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (5,721,026) in view of Dubief et al. (6,024,946).

The instant invention is directed to a composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising 0.05-10% non-aminated silicone alpha, omega-disilanol, 15-35% propellant, and a cosmetically acceptable medium, wherein the composition is in the form of an aerosol. Feder et al. teach aqueous silicone/copolymer dispersions crosslinkable into an elastomeric state. Disclosed is a composition comprising an oil-in-water base emulsion of an alpha, omega-(dihydroxy)polydiorganosiloxane stabilized with a surfactant, an aqueous latex of an organic copolymer, a cross-linking agent, a filler, and a metal curing catalyst. The organic monomers are selected from alkyl(meth)acrylates, unsaturated esters of monocarboxylic acids, vinylaromatic compounds, and others. The composition is disclosed for cosmetic use for the treatment of hair. See Example 1, Table 1; Col. 1, line 10-Col.7, line 54; Col. 11, line 6-Col. 24, line 56. The

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reference does not teach percent weight of the silicone, propellants, a hair setting lotion, and a process of rinsing the hair.

Dubief et al. teach a composition for the treatment of keratinous materials consisting essentially of in an aqueous medium, at least one silicone, at least one latex consisting of a colloidal suspension of polymer particles insoluble in said aqueous medium, and at least one suspension agent for the silicone and the latex and/or at least one thickening agent. Non-aminated silicone alpha-omega-disilanolols are taught as silicones. Specifically disclosed is a non-rinsed conditioner comprising an o/w emulsion of acrylamide/sodium 2-methyl propanesulfonate acrylamide copolymer, a latex of vinyl acetate/acrylic ester copolymer, and a mixture of octamethylcyclotetrasiloxane dimethiconol and dodecamethylcyclopentasiloxane. The silicones comprise 0.1-50% of the composition and the polymer particles comprise 3.1-10% of the composition. Propellants are disclosed as additives. The compositions may be used as a rinsed or non-rinsed treatment lotion for application before or after shampooing, before or after perming, before or after dyeing or bleaching or between two perming or straightening steps. See Col. 1, line 25-Col. 14, line 32.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the propellant taught by Dubief et al. into the invention of Feder et al. because of the expectation of achieving a hair care composition, wherein the application of the composition can be controlled in amount and place.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the percent weight teachings of Dubief et al. into the invention of Feder et al. because it has been held that where the general conditions of a claim are disclosed in the

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prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

The Examiner respectfully points out that the limitations "at least one propellant" "wherein the composition is in the form of an aerosol" of the instant independent claims, necessitates that the composition be pressurized in an aerosol container. The Examiner respectfully points out the Webster's dictionary definition of propellant is "a gas kept under pressure in a bottle or can for expelling", and that the Webster's Dictionary definition of aerosol is "a substance (as an insecticide or cosmetic) dispensed from a pressurized container especially as an aerosol; also :the container for this". Thus, the teaching of a propellant in Dubeif et al. necessitates a composition in a pressurized aerosol container.

The claims are directed to a composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising 0.05-10% non-aminated silicone alpha, omega-disilanol, 15-35% propellant, and a cosmetically acceptable medium, wherein the composition is in the form of an aerosol. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to keratinous substances, such as hair, of compositions containing the same components as instantly claimed, which would inherently be a hair-setting lotion, as instantly claimed. Applicant has not provided

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any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder et al. in view of Dupuis et al. as applied to claims 18-21, 24-26, 28-32, 35, 36, 40-45 above, and further in view of Blankenburg et al. (6,153,179).

Feder et al. and Dupuis et al. are applied as discussed above. The reference does not teach preferred propellants.

Blankenburg et al. teach hair setting lotions comprised of a nonionic or anionic homo or copolymers of at least 70% by weight of N-vinylcaprolactam and a film-forming polymer. T-butyl acrylate/ethyl acrylate/methacrylic acid is disclosed as a film forming polymer. The hair setting lotion is disclosed as a hairspray comprising propane, butane, dimethyl ether, nitrogen, nitrous oxide or carbon dioxide as propellants. See Col. 1, line 11-Col. 4, line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach propane, butane, dimethyl ether, nitrogen, nitrous oxide or carbon dioxide, as taught by Blankenburg et al., as the propellants of the combined references because of the expectation of achieving a cosmetically acceptable aerosol composition for application to the hair.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder et al. in view of Dupuis et al. as applied to claims 18-21, 24-26, 28-32, 35, 36, 40-45 above, and further in view of Audousset et al. (6,106,577).

Feder et al. and Dupuis et al. are applied as discussed above. The reference lacks preferred polymer particles.

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Audousset et al. teach the use of a composition containing a film-forming polymer aqueous dispersion and non-melanic pigment for temporarily dyeing hair. Film-forming polymers disclosed include (meth)acrylic acid/ethyl acrylate/ methyl methacrylate terpolymers, methyl methacrylate/butyl acrylate/ hydroxyethyl methacrylate/methacrylic acid tetrapolymers, and ethyl acrylate/methyl methacrylate/acrylic acid/methacrylic acid copolymers.. It is disclosed that the aqueous dispersions of the polymers may be in the form of a latex. Silicones are disclosed as adjuvants for use in the composition. The film-forming agents are taught as imparting stability to emulsions, so much so that a surfactant is not necessary. See Col. 1, line 6-Col. 10, line 49.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the specific polymer particles taught by Audousset et al. for those taught by the combined references because the combined references generally teach the inclusion of such polymers in their compositions and because of the expectation of achieving a stable emulsion, wherein a surfactant is not necessary.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.



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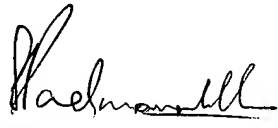
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

March 11, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER 3/23/03